

REMARKS

The pending claims are 1-5, 7-18, 20-22, and 24-38.
(Applicant's attorney erroneously stated in response to the previous office action that the pending claims also included claim 19, but that claim had been canceled in the response to the previous Office action. Applicant's attorney apologizes.)

The Office Action Summary incorrectly indicates the Office examined claims 1-5, 7-17, 20-22, and 25-37. It is clear from the Office action itself, though, that claims 1-5, 7-18, 20-22, and 24-38 were examined.

Of the claims examined, all but claims 15-16 and 32-33 were rejected. With this paper, the claims are unchanged, and reconsideration is requested. Thus, claims 1-5, 7-18, 20-22, and 24-38 remain pending.

Rejections under 35 USC §101 (and also 35 USC §112, first paragraph)

At section 3 of the Office action, claim 34 is rejected under both 35 USC 101 and 35 USC 112, first paragraph, as "not supported by either a specific asserted utility or a well established utility." The Examiner argues that "The original disclosure doesn't support that a computer program product can be or may be performed by various combinations of software and hardware."

Applicant respectfully first argues that neither 35 USC 101 nor 35 USC 112, first paragraph, require support of claimed subject matter by either a specific asserted utility or a well established utility. 35 USC 101 simply requires that an invention be useful. There is no requirement of disclosure in this respect. Likewise, there is no requirement of disclosure in this respect by 35 USC 112, first paragraph.

Further, nowhere does applicant assert that "a computer program product can be or may be performed by various combinations

of software and hardware." A computer program product, as claimed in claim 34, is e.g. a disk (i.e. a computer readable storage structure) having stored on it a computer program in a form readable by a computer for execution by a computer processor. A "computer program product" is nowhere described or claimed by applicant as that which "can be or may be performed by various combinations of software and hardware." If the Office makes the statement "performed by various combinations of software and hardware" because claim 18 recites "receiving from another communication device, via a short-range transceiver in a communication device, information indicating an identifier of the other communication device," and the Office interprets this to mean that the computer program product of claim 34 includes a short-range transceiver, applicant respectfully points out that the claim recites "via a short-range transceiver." In other words, claim 18 does not recite a short-range transceiver receiving information, but rather recites a process responsive to information provided via a short-range transceiver (and also via a communication channel to the other communication device). The "receiving" is, therefore, to be understood as "accepting an input." The method recited in claim 18 then processes the input, determining whether the identifier of the other communication device indicates a buddy in a buddy list data store, and so on.

Further with regard to the rejection under 35 USC 101, a computer program product, as claimed in claim 34, in view of the capabilities of the computer program included in the computer program product, is indisputably useful--it lets a user know if a buddy (a user indicated on a buddy list) is nearby, by virtue of its dependency from claim 18--and therefore passes muster under 35 USC 101 as having utility and so is statutory.

Further in regard to the rejection under 35 USC 112, first paragraph, support for the invention as in claim 34 is e.g. at page 6, in the paragraph there beginning line 1. Claim 34 is thus

allowable under 35 USC 112, first paragraph.

Accordingly, applicant respectfully requests that the rejections under 35 USC §101 and 112, first paragraph, be reconsidered and withdrawn.

Rejections under 35 USC §102

At section 5 of the Office action, claims 18 and 38 are rejected under 35 USC §102 as being anticipated by U.S. Pat. Appl. Pub. No. 2004/0064693 (Pabla).

Claim 18 recites receiving from another communication device, via a short-range transceiver in a communication device, information indicating an identifier of the other communication device, and determining whether the identifier of the other communication device indicates a buddy in a buddy list data store and if so, providing to an annunciator a control signal actuating the annunciator to indicate to a user receiving the information indicating the identifier of the other communication device. Pabla, on the other hand, teaches a system in which a user provides a buddy list to a server of a chat session, and the server monitors users participating in the chat session and if a user joins who is on the buddy list, the server notifies the provider of the buddy list. There is no teaching or suggestion of using information provided via a short-range transceiver, which therefore restricts the detector of the invention as claimed to notifying a user when a buddy is nearby. In Pabla, on the other hand, the "buddy" could be on the other side of the world.

Further, Pabla does not teach providing a control signal to an annunciator in the sense used in the application. Pabla teaches merely notifying a user, which is clearly done merely by a text message since no description is given, that a buddy has joined the chat session. At page 9, line 25, the application explains that an annunciator is "a device generating one or

another type of stimulus, such as a light generator 17a or a sound generator 17b or a vibration generator 17c." Applicant respectfully disputes the meaning attached to the term "annunciator" by the Office; applicant submits that an "annunciator" as used in the application does not encompass providing notification in the form of a mere text message (for lack of other description). The claim does not merely recite "notifying" the user, but instead specifically recites providing a control signal to an annunciator. The obvious intent is to alert the user even when the user is not looking at or using the communication device.

The Office may assert that limitations are not to be read into the claims, but applicant respectfully submits that it is proper and necessary for the Office to look to the specification to interpret "annunciator." The Federal Circuit, in *Phillips vs. AWH Corp.*, 415 F.3d 1303, 75 USPQ.2d 1321 (Fed. Cir. 2005), an *en banc* decision, explained again that:

[T]he specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term.

The court further explained:

That starting point [for understanding a claim term] is based on the well-settled understanding that inventors are typically persons skilled in the field of the invention and that patents are addressed to and intended to be read by others of skill in the pertinent art. ... Importantly, the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification.

The application distinguishes between using an annunciator and "notifying" (indicating) information to a user. At page 9, beginning at line 22, the application notes that the buddy detector activates the annunciator upon detecting a buddy:

... the UE device 12 includes ... a buddy detector application ..., for receiving information including an identifier indicating a peer device or a user associated with a peer device, and in response providing to the annunciator 17a-c a control signal

actuating the annunciator 17a-c, depending on the identifier
...

At page 10, beginning line 10, the application explains:

The buddy detector also indicates to the user an identity for the buddy--such as the identifier received from the buddy or a nickname associated with the identifier if the identifier is not the nickname. Thus, the enhanced mobile 11 notifies a user that a buddy is nearby, in case the user wants to communicate with the buddy either via the BT TRX or otherwise.

Thus, an annunciator, as that term is used in the application, is more than a notification service as that term is used in Pabla. The notification service of Pabla, which clearly provides a mere text message, cannot therefore be interpreted as the recited annunciator when the application in effect distinguishes providing a mere notification (an indication) versus actuating an annunciator.

The argument with respect to the annunciator applies also to claim 38. Although claim 38 does not recite an annunciator as a component of the module to which the claim is directed, it recites providing a control signal for such. This must be understood as different than providing a control signal for a text message, for the same reasons given in respect to claim 18.

Accordingly, applicant respectfully requests that the rejections under 35 USC §102 of claims 18 and 38 be reconsidered and withdrawn.

Rejections under 35 USC §103

At section 7 of the Office action, claims 1-5, 7-14, 17, 20-22, 25-31 and 35-37 are rejected under 35 USC §102 as being unpatentable over U.S. Pat. No. 6,999,721 (Ollis) in view of Pabla.

Of these, claims 1 and 35 are independent.

Claims 1 and 35

Claim 1 recites an annunciator, and also a buddy detector application, with the latter responsive to information received by a short-range transceiver, which information includes an identifier indicating another communication device, for providing to the annunciator a control signal actuating the annunciator if and only if the identifier is included in a buddy list data store. Method claim 18 recites corresponding limitations.

As mentioned in response to the previous Office action, Ollis discloses a list of found devices that are temporarily near enough for communication of messages via one of the wireless transfer mechanisms, other than cellular, disclosed in Ollis, such as Bluetooth, and various stages in the communication of a message (conveying an "object") to several of the found devices. No use of a buddy list is used to activate an annunciator if a device associated with a buddy on a buddy list is found. The list of devices shown in Figure 4 is not a buddy list: it is a list of the found devices, and there is no indication in Ollis that other than all found devices appear on the list.

The Office notes that Ollis fails to disclose a buddy list data store, for holding a list of identifiers, with the list organized as records so as to be able to retrieve a record based on the identifier; and a buddy detector application, responsive to the information included in the identifier indicating the other communication device, for providing to the annunciator a control signal actuating the annunciator if and only if the identifier is included in the buddy list data store. For this, the Office relies on Pabla, at figure 1B and paragraphs 92-94.

As mentioned, Pabla teaches a mechanism by which a peer node in a peer-to-peer network can learn when a buddy, i.e. another peer node referred to as a buddy, has joined a chat session. Paragraphs 92-94 of Pabla read:

[0092] One embodiment may provide a message to register for join notifications. Peer nodes may use the message to register to be notified when certain other peers join or insert themselves into the distributed index. When a peer joins a session, peers already present in the session who have registered to be notified if the peer joins the session may be notified of the peer joining the session. This embodiment may be used, for example, as a presence system for buddy list-type notifications in chat applications.

[0093] As an example, a first peer may join a chat session. Information corresponding to the first peer may be stored in the distributed index. The first peer may register to be notified if and when other specified peers join the chat session. When a specified second peer joins the chat session, the second peer's presence information is registered in the distributed index. Because the first peer has registered to be notified if the second peer joins, the first peer is notified of the second peer's presence in the chat session.

[0094] If a peer desires to be informed of the presence of another peer, the peer registers a query for the other peer (e.g. "look for peer X") in the distributed index. Whenever the other peer joins, the peer that registered the query for the other peer may be notified by the notification service that the other peer has joined. In one embodiment, the notification service may provide information on how to contact the other peer to the peer that registered the query.

The objects of Ollis and Pabla are different. The object of Ollis is to deliver a message from a sender terminal to an intended recipient, making use of whatever devices/ terminals are reachable for communication with the intended recipient. As set out in col. 1, line 63:

Accordingly, what is desired are systems, methods and computer program products for transferring objects using one of multiple wireless transfer mechanisms without requiring that the user designate a particular wireless transfer mechanism.

The object of Pabla, on the other hand, is to inform a participant in a chat session when a person on a buddy list has joined the chat session. For Ollis, the intended recipient is known. There is no buddy list, and there is no need of a buddy list. There is, however, a list of devices potentially useable in communicating with the intended recipient of the message to be delivered. The Office asserts that: "It would have been obvious ... to combine the

teaching of Pabla with Ollis device such that it provides mobility and enhanced connect ability to each individual peer." But if the Office is asserting that it would have been obvious to replace the device list of Ollis with the buddy list of Pabla, the combination made by the Office would be improper because it would change the system of Ollis so as to achieve a different object. Per the MPEP at 2143.01 V., (having the caption "THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE"), if a proposed modification would render the prior art invention being modified (Ollis in this case) unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. For this, the MPEP cites *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

If, on the other hand, the Office is asserting that simply adding a buddy list to Ollis (and also a buddy detector), so that Ollis would then have a buddy list and a device list, applicant respectfully submits that the combination is one being made purely in hindsight, and so is again improper. Where is the motivation to combine, as required by MPEP 706.02(j). The MPEP at section 706.02(j) requires that in combining references, an Examiner must make a *prima facie* case of obviousness. To do so, the Examiner must show that there is "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." Instead of making such a showing, the Office merely asserts that the combination (not made express) "provides mobility and enhanced connect ability to each individual peer." Applicant respectfully submits this is merely an excuse for indulging in hindsight reconstruction. The law requires more, otherwise any test for combining references is really illusory.

Further, the motivation given is suspect: providing a buddy list does not provide "mobility" to Ollis. Ollis discloses wireless communication devices. The mobility is already there.

As far as "enhanced connect ability," Ollis already teaches the maximum connect ability. Ollis teaches trying every communication device known to be used by the intended recipient in order to try to connect with the intended recipient. The use of a buddy list is irrelevant to the issue of connect ability.

Further still, the buddy list of Pabla is not a list of buddies who are close by, as in the invention as claimed, but a list of buddies whose participation in a chat session is to be indicated to the owner of the list. Thus, even the combination of Ollis and Pabla in the sense of wholesale addition of the functionality of Pabla to Ollis (so that Ollis still achieves its intended purpose using its device list, but also includes a buddy list as in Pabla) does not yield the invention as in the rejected claims. The buddy list of Pabla (and the detector of Pabla that would indicate to the owner of the list when a buddy has joined a chat session) do not indicate when a buddy is nearby. The short range transceiver of the claims, providing information indicating an identifier that is then checked by the buddy detector application to see if it identifies a buddy, in effect alerts the user that a buddy is nearby. Thus, the additive combination of Ollis and Pabla does not even include all of the limitations of the invention as in claim 1, as also required by MPEP at 706.02(j).

The same argument applies to claim 35.

Accordingly, applicant respectfully requests that the rejections of claim 1 and 35 under 35 USC §103 be reconsidered and withdrawn.

Claims 10 and 27

Claim 10 further recites: a store and forward service application, for receiving communications via the short-range transceiver, for determining whether the communications have as an intended recipient a device peer to the apparatus but other than

the apparatus, and for retransmitting any such communications via the short-range transceiver and including in the retransmission an identifier indicating a user of the apparatus, thereby providing to peer devices an increased-range short-range communication facility and allowing the user to take credit for providing the facility. Pabla does not teach including an identifier of a user of the apparatus providing a retransmission.

The same argument applies to claim 27, although no reasons are given for the rejection of claim 27 nor does the Office indicate where in the cited art the claim limitations are to be found, and claim 27 is therefore believed allowable, since per 37 CFR 1.104(c)(2), the examination must show where in the art the limitations are to be found), i.e.:

When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Claims 11-13 and 28-30

Claims 11-13 further recite a controller adapted to receive from another device a request for permission to control a stimulus generator, to present the request to a user via the user equipment user interface, to signal the user response to the request, to receive command signals from the other device indicating commands to cause one or another of various available stimuli sensations, and to provide stimulus control signals corresponding to the received command signals. The Office does not show or assert that the prior art teaches or suggests a controller receiving command signals from another device, let alone a controller giving permission to the other device (with the approval of a user) to send such commands. The Office asserts merely that Pabla teaches "central processor for controlling all the operation and application programs," citing col. 8, lines 3-17. Applicant notes that the ref. to col. 8, lines 3-17 of Pabla is evidently in

error, as Pabla (a publication of an application, not an issued patent) has no numbered columns, and actual col. 8, lines 3-17, is not related to the issue at hand (but instead discusses hashing). Applicant supposed the Examiner might mean Ollis. But col. 8, lines 3-17 of Ollis is also irrelevant.

The same argument applies to claims 28-30.

For the reasons given, applicant respectfully requests that the rejections of claims 10 and 27 and also claims 11-13 and 28-30 under 35 USC §103 be withdrawn.

Other rejected claims

The other rejected claims, though not argued, are believed allowable at least by virtue of their dependencies and because their rejections depend on the rejections of the claims argued here, and so applicant respectfully requests that their rejections be withdrawn.

Conclusion

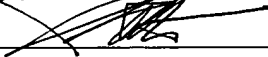
For all the foregoing reasons it is believed that all of the claims of the application are in condition for allowance and their passage to issue is earnestly solicited.

10 Nov. 2006_____

Date

WARE, FRESSOLA, VAN DER SLUYS
& ADOLPHSON LLP
755 Main Street, P.O. Box 224
Monroe, CT 06468-0224

Respectfully submitted,



James A. Retter

Registration No. 41,266

tel: (203) 261-1234

Cust. No.: 004955